DOCKET NO.: 93-03-015 **PATENT**
CLIENT NO.: EDSC01-93015
Customer No.: 34279

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	:	Brent Dalmas Nelson, et al.
U.S. Serial No.	:	10/675,075
Filed	:	September 30, 2003
For	:	ENTERPRISES TAXONOMY FORMATION METHOD AND SYSTEM FOR AN INTELLECTUAL CAPITAL MANAGEMENT SYSTEM
Art Unit	:	2129
Examiner	:	Peter D. Coughlan

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal. The review is requested for the reason(s) stated in the arguments below, demonstrating the clear legal and factual deficiency of the rejections of some or all claims.

Claims 1-20 are pending the application. Claims 2 and 11 were rejected as indefinite for the term "internal consistency". Claim 2 requires, for example, "the step of determining internal consistency within each of said plurality of local taxonomies." Applicant has indicated that the concept of internal consistency is well known, that there are established dictionary definitions, and one of ordinary skill in the art would understand the plain meaning of the words. Examiner Coughlin now alleges, in the Advisory Action, that "internal consistency" is a relative term and there is no measure of "consistency" stated. Examiner Coughlan is incorrect; this is not a relative term. Either a structure such as a taxonomy is internally consistent or it isn't – there is nothing relative about it, as one of ordinary skill in the art would understand. The rejection is factually deficient.

Claims 6 and 15 were rejected as indefinite for the phrase "higher order language", which does not appear in these claims. In the Advisory Action, Examiner Coughlan describes this as a "typographic error" that should have read simply "higher order". However, as the paragraph supporting this rejection indicates that Examiner Coughlan is concerned with a comparison of languages, Examiner Coughlan clearly has not made an analysis as to why the phrase(s) used in the claim is "vague and indefinite" or included it in the Office Action as required by MPEP 2173.02. The rejection is legally deficient.

Claims 1-20 were rejected as non-statutory subject matter. For the convenience of the panel, claim 1 reads:

> 1. (Original) A method for constituting an integrated enterprise taxonomy for an intellectual capital management system serving a plurality of local enterprise communities, comprising the steps of:

> extracting a plurality of local taxonomies from the plurality of local enterprise community models;
>
> correlating from each of said plurality of local taxonomies a set of topics and a set of associations for generating a correlated topics and associations set relating to each of said plurality of local taxonomies;
>
> deriving a plurality of synonym links for linking synonyms within said correlated topics and associations set;
>
> integrating said plurality of synonym links and said correlated topics and associations set into an integrated enterprise taxonomy; and
>
> exporting said integrated enterprise taxonomy into said intellectual capital management system.

Examiner Coughlin argues that the claimed steps amount to "nothing more than an exercise in cataloging information," then apparently argues that cataloging information is not useful, concrete, and tangible. As a general statement, this is, of course, simply incorrect. Indeed, the entire operation of the USPTO examining system is based on a system of cataloging and classifying information.

The Examiner complains that the "applicant fails to demonstrate the real world purpose or function, [*sic*] which the invention executes." Claim 1 clearly produces an integrated taxonomy from a plurality of local taxonomies, using specific techniques for associating various parts of the taxonomies. The Examiner is invited to study, e.g., paragraphs 0007-0009 of the specification as filed for a description of the value and "real world purpose" for such an integrated taxonomy.

Applicant has directed Examiner Coughlin to the discussion in the specification of the advantages of a combining multiple discrete taxonomies into a single integrated taxonomies. Applicant has directed Examiner Coughlin to other references indicating what those of ordinary skill in the art understand about enterprise taxonomies. Still, Examiner Coughlin wonders, "What does

'an integrated enterprise taxonomy' do?" As described in the specification, it combines multiple different taxonomies, with their different terms, abbreviations, acronyms, topics, associations, etc., into a uniform taxonomy structure. This is clear to one of ordinary skill in the art.

The only relevant inquiry is whether the claimed methods and systems produce a result that is useful, concrete, and tangible. Each of these claims includes producing an integrated enterprise taxonomy. This result is useful, concrete, and tangible, as described in the background section of the instant application, and the novel process for producing the taxonomy is described throughout the application. Those of skill in the art recognize the value of such a taxonomy. The statutory subject matter rejections are legally and factually deficient.

Claims 1-4, 7-13, and 16-19 were rejected as anticipated by anticipated by *Schmitz* (U.S. Patent Publication No. 2003/0149567, hereinafter Schmitz). Schmitz does not teach or suggest anything about the claimed enterprise community models, and does not teach or suggest extracting a plurality of local taxonomies.

At best, Schmitz describes a single "natural language taxonomy" stored in a "taxonomy database". There is no teaching or suggestion at all of any plurality of local taxonomies, and so the Schmitz cannot anticipate the plain language of the claims. That Schmitz references a "taxonomy database" only indicates admits to a single taxonomy, not a plurality of taxonomies, as required by the claims. There is no teaching or suggestion at all of multiple taxonomies in Schmitz, and so the claimed method cannot be performed by Schmitz, and certainly is not anticipated by Schmitz.

Further, Examiner Coughlin makes a series of statements of what he believes to be "equivalent" between various claim elements and various elements of Schmitz. There is no support

at all for these statements, and Examiner Coughlin does not provide any reasoned basis at all.

The art rejections are legally and factually deficient.

CONCLUSION

As a result of the foregoing, the Applicant asserts that the claims in the Application are in condition for allowance over all art of record, and that the rejections are both factually and legally deficient, and respectfully requests this case be returned to the Examiner for allowance or, alternatively, further examination.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 05-0765.

Respectfully submitted,

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Date: 2/22/7

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